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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/716,909 | 11/19/2003 | Robert Longman | | 7053 |

7590 05/07/2008

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| EXAMINER | |
|---|---|
| SHAH, AMEE A | |
| ART UNIT | PAPER NUMBER |
| 3625 | |
| MAIL DATE | DELIVERY MODE |
| 05/07/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/716,909 | LONGMAN ET AL. | |
| | Examiner | Art Unit | |
| | Amee A. Shah | 3625 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *18 June 2007*.

2a)☐ This action is FINAL. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *11-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

Claims 11-44 are pending in this action.

### *Response to Amendment*

Applicant's amendment, filed June 18, 2007, has been entered. Claims 1-10 have been cancelled. Claims 11-44 have been added. In view of the amendment, the requirement for election no longer applies.

### *Specification*

The spacing of the lines of the specification is such as to make reading difficult. New application papers with lines 1½ or double spaced on good quality paper are required.

Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Abstract is objected to because it is longer than 150 words and because it contains such phrases as "the invention provides."

***Examiner Note***

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 21, 32 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15, 21, 32 and 38 recite the limitation of a reception from the buyer of "at least one counter-counter offer responsive to the at least one counter offer." However, the counter offer referred to in the claims is one made by the buyer in response to the sealed offer from the seller (*see* claims 11, 13, 17, 19, 28, 30, 34 and 36). It is not clear to one of ordinary skill in the art how a buyer would be able to counter his/her own counter offer. For

purposes of this action only, the Examiner will interpret the claims as the seller responding to the buyer's counter offer with a counter-counter offer.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> > (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 11-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohavi et al., US 2005/0119980 A1 (hereafter referred to as "Kohavi").**

Referring to claim 11, Kohavi discloses a system controller, comprising a processor and a memory storing instructions operable with the processor for operating a system controller in conducting a wish list auction for an item involving a buyer and at least one seller (see, e.g., ¶¶0016 and claim 60), the instructions being executed for:

- facilitating a reception by the system controller from the buyer of a request for the item (Figs. 1 and 2, "106" and "206" and ¶¶0032 and 0033– note the request for an item is the request for a flight/hotel room);
- facilitating a reception by the system controller from the at least one seller of at least one sealed offer responsive to the request for the item from the buyer (Figs. 1 and 2, "108" and

"208" and ¶¶0006, 0032 and 0033 – note that Kohavi points out it is old and well known for offers to be sealed and that the offer responsive to the request is the default ticket price offer); and

- facilitating a reception by the system controller from the buyer of an acceptance of at least one of the at least one sealed offer (Figs. 1 and 2, "118" and "218" and ¶¶0032 and 0033 – note the buyer may accept at any time).

Referring to claim 12. Kohavi further discloses the system controller of claim 11 wherein the item includes at least one of a good, a service, a right and a property (¶0016 – note that the item can be a product, i.e. good, or any other article). Furthermore, while Kohavi discloses the item including at a least a good, whether the item is a good, service, right or a property is nonfunctional descriptive material that would not distinguish the claimed apparatus from the prior art. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *see In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a " recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (Bd. Pat. App. & Inter. 1987). Thus the structural limitations of claim 12, including a controller to receive requests, offers and acceptances are disclosed in Kohavi as described herein. Also as described, the non-functional descriptive material will not alter the way the items are requests, offers submitted or acceptances given, and will not distinguish the claimed invention from the prior art Kohavi in terms of patentability. *See In re Gulack*, 703 F.2d

1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to claim 13. Kohavi further discloses the system controller of claim 12 wherein the instructions are further executed for facilitating a reception by the system controller from the buyer of at least one counter offer responsive to the at least one sealed offer (Figs. 1 and 2, "110" and "210" and ¶¶0032 and 0033).

Referring to claim 14. Kohavi further discloses the system controller of claim 13 wherein the instructions are further executed for facilitating a reception by the system controller from the at least one seller of an acceptance of the at least one counter offer (Fig. 2, "216" and ¶0033 – note that either party can accept at any time).

Referring to claim 15. Kohavi further discloses the system controller of claim 14 wherein the instructions are further executed for facilitating a reception by the system controller from the at least one seller of at least one counter-counter offer responsive to the at least one counter offer (Figs. 1 and 2, "112" and "212" and ¶¶0032 and 0033).

Referring to claim 16. Kohavi further discloses the system controller of claim 15 wherein the instructions are further executed for facilitating a reception by the system controller from buyer of an acceptance of the at least one counter-counter offer (Figs. 1 and 2, "118: and "218" and ¶¶0032 and 0033 – note that the buyer can accept at any time).

Referring to claims 17-26 and 28-43. All of the limitations in apparatus and method claims 17-26 and 28-43 are closely parallel to the limitations of apparatus claims 11-16 analyzed above and are rejected on the same bases.

Referring to claim 27. Kohavi further discloses the seller client terminal of claim 25 wherein the instructions are further executed for facilitating a decline by the seller client terminal of the counter-offer (Figs. 5 and 6, "516" "610" and ¶¶0063 and 0067-0075).

Referring to claim 44. All of the limitations in method claim 44 are closely parallel to the limitations of apparatus claim 27 analyzed above and are rejected on the same bases.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11, 12, 17, 18, 23, 24, 27, 28, 29, 34, 35, 40, 41 and 44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12, 13, 16, 20, 21, 23, 25, 26, 33, 37, 38, 42 and 43 of copending Application No. 10/696,441, and over claims 1-11 of copending Application No. 10/720,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the claims are directed to operating an auction by receiving, accepting and declining sealed offers for items.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Conklin et al., US 6,332,135 B1, teaches a system and method for negotiating between buyers and sellers prices and other conditions for goods and services including providing proposals and counteroffers (see, e.g., Abstract and columns 18-25).

(2) Gillman, US 2002/0147674 A1, teaches a system and method for a reverse auction whereby the sellers and buyers negotiate with offers and counteroffers, in secret if desired (see, e.g., pages 2-9).

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site http://www.uspto.gov in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh C. Garg can be reached on 571-272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

July 2, 2007